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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,672	06/19/2000	James Hongxue Wang	11302-0601 (KC 15,993)	3964

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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

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DATE MAILED: 05/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/595,672

Applicant(s)

WANG ET AL.

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The amendment filed 02/21/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "number-average molecular weight" @ page 9, line 20.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. Claims 1-11 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As far as the Examiner can tell, no support can be found for the newly added limitation "wherein the graft copolymer of poly(ethylene oxide) is prepared from poly(ethylene oxide) resins with number average molecular weights of about 100,000 g/mol to about 8,000,000 g/mol" per claims 1 and 14 and this, as such, without any guidelines from applicant as to where support might be found, this engenders a New Matter situation.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumi et al or Miyamoto et al in combination with Ray-Chaudhuri et al.

Sumi et al and Miyamoto et al disclose hot melt adhesive compositions, suitable for paper making such as bookbinding, wherein said compositions are defined basically as containing a polyvinyl alcohol-governed melt mixture wherein, components of the polyvinyl alcohol-governed melt mixture are melt blended via means of, e.g., a melt extruder and a vent-type extruder(col. 4, lines 64-67 of Miyamoto et al and col. 8, lines 1-12 of Sumi et al, respectively) . See, additionally, the Abstract and the Runs of each of Sumi et al and Miyamoto et al and especially col. 8, lines 13-17 of Sumi et al and col. 5, lines 5-10 of Miyamoto et al wherein the use of other commonly used additives in hot melt adhesive compositions are highly invited. The disclosures of each of Sumi et al and Miyamoto et al differ basically from the claimed invention as per the non-express guidelines to incorporate, into the hot melt adhesive blend compositions, a graft copolymer of poly(ethylene oxide), as claimed.

Ray-Chaudhuri et al teach similar such hot melt adhesive compositions, useful in bookbinding, and defined basically as containing a melt mixture of at least a water-soluble, graft copolymer of a poly(ethylene oxide) wherein the graft copolymer is derived from a water-soluble poly(ethylene oxide)governed by a molecular weight of from 3,000 to 20,000 and from vinyl monomers which include vinyl acetate, alone or in combination with other comonomers such as 2-hydroxyethyl acrylate, etc., for grafting onto said water-soluble poly(ethylene oxide) backbone . See, e.g., the Abstract, the paragraph bridging cols. 2-3, cols. 3-6, especially col. 6, lines 22-43 and the Runs of Ray-Chaudhuri et al. Therefore, it would have been obvious to the skilled artisan to add the graft copolymer of poly(ethylene oxide) of Ray-Chaudhuri et al to the polyvinyl alcohol-governed melt mixture of Sumi et al or Miyamoto et al and with a reasonable expectation of obtaining the cumulative, additive effect. By the same token, it would have been obvious to the skilled artisan to add the polyvinyl alcohol component of Sumi et al or Miyamoto et al to the hot melt adhesive composition of Ray-Chaudhuri et al and with a reasonable expectation of obtaining the cumulative additive effect. Criticality for such, fully commensurate in scop

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with the claimed invention, not having been demonstrated on this record. It is well established that no patentable invention resides in combining old ingredients of known properties. The combination of two compositions, each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition that is used for the very same purpose is prima facie obvious as authorized by In re Kerkhoven(205 USPQ 1069, CCPA 1980).

As to the properties such as compatibility and the absence of visible gel particles per claims 19 and 21, it is tenable that these properties would be met by the prior art combination rejection since the prior art, as modified supra, is essentially the same as the claimed invention. There is nothing viable on this record diffusing this issue. Moreover, the discovery that the claimed composition possesses properties not disclosed for in the prior art does not alone defeat a prima facie case of obviousness, i.e., it is not necessary, in order to establish a prima facie case of obviousness, that both a structural similarity between a claimed and prior art compound or composition be shown and that there be a suggestion in or expectation from the prior art that the claimed compound or composition will have the same or similar property or utility as the one newly discovered by applicant as provided for under the guise of In re Dillon, 919 F.2d 688, 16 USPQ2d 1897, 1901(Fed. Cir. 1990).

As to the "consists essentially of" transitional phrase per claim 23, such only precludes those components that would materially alter the basic and novel characteristics of applicants claimed composition as provided under the guise of Ex parte Davis(80 USPQ 448) and In re Janakirama-Rao(317 F 2d 951, 137 USPQ 893).

Response to Arguments

5. **Applicant's arguments filed 02/21/03 have been fully considered but they are not persuasive.**

Relative to Sumi et al or Miyamoto et al with Ray-Chaudhuri et al—It is urged and maintained that the instantly claimed invention is obvious within the meaning of 35 USC

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103 over Sumi et al or Miyamoto et al in combination with Ray-Chaudhuri et al as per reasons clearly set forth in the Grounds of Rejection supra.

The crux of Counsel's arguments appear to hinge on the poly(ethylene) oxide component used to make the graft copolymer of poly(ethylene oxide) per Ray-Chaudhuri et al does not meet the poly(ethylene oxide) component governed by a number average molecular weight of about 100,000 g/mol to about 8,000,000 g/mol, as claimed. However, with all due respect to counsel's opinion, the claims subject to the rejection under 35 USC 103(a) over patentees are not so limited.

Counsel is herein apprised that if the New Matter situation supra is resolved via cancellation of the subject matter that raised the New Matter issue, the prior art rejection will be reinstated.

Allowable Subject Matter

6. *Claims 1-16 are deemed allowable over the prior art of record.*

Conclusion

7. *Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).*

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

J. M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *JMR*
May 25, 2003